102790-54
A13470 US

REMARKS

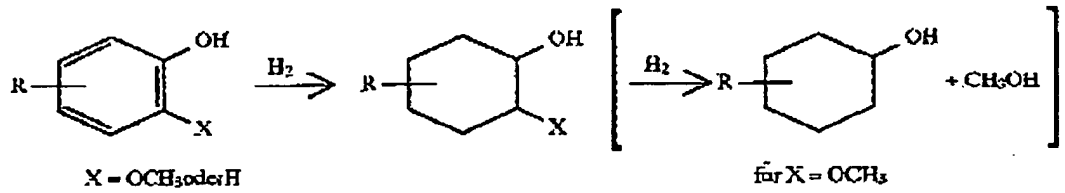
Status of Claims

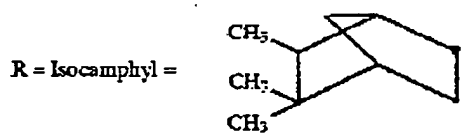
Claims 1-18 are currently pending. A Notice of Appeal is being filed concurrently with this application.

35 U.S.C. 103(a) rejection

Claims 1-18 were rejected by the examiner as being obvious over Darsow (U.S. Patent 5,874,648) in view of Hall et al. (U.S. Patent 4,104,203) and Robinson et al. (U.S. Patent 5,116,602).

The applicants previously argued that the process taught by Darsow did not teach the formation of methoxylated isocamphylcyclohexanols as is claimed by the applicants. The examiner responded in the final rejection (lines bridging pages 2 and 3) that "Compounds having the carbon skeleton of isocamphylguaiacol would have the methoxy group attached to the cyclohexanol and, thus the reference teaches the claimed compounds as discussed in the previous office action." However, this is incorrect. Copied below is the relevant section of Darsow's process:





What the above process discloses is that the isocamphylphenols (X = OCH_3 oder ("or") H) is hydrogenated to form an isocamphylcyclohexanol if X = H (the middle structure) or forms isocamphylcyclohexanol and methanol when X = OCH_3 (für ("for") X = OCH_3). There is nothing within the specification which suggests the formation of the applicants claimed ***methoxylated*** isocamphylcyclohexanols. Every section (Title, Background of the Invention, Summary of the Invention, etc.) of the Darsow reference is directed to the formation of isocamphylcyclohexanol.

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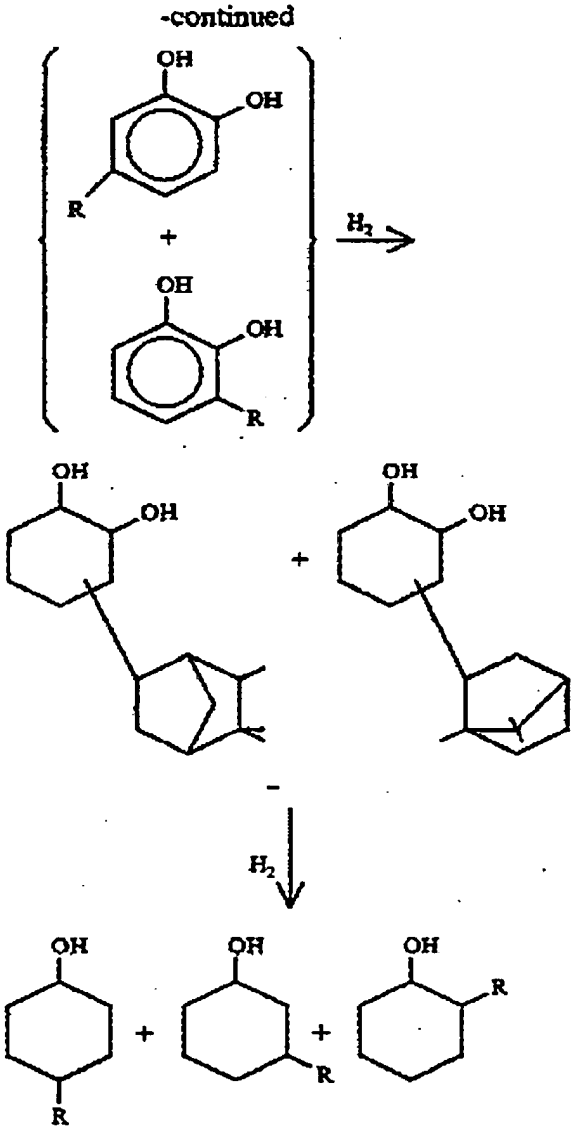
The Hall et al. and Robinson et al. do not remedy the deficiencies of the Darsow reference. Hall et al. is a two step hydrogenation but is unlike Robinson in that the intermediate product after the first hydrogenation is a diol. Moreover, in Hall et al. the product after each of their hydrogenation steps is not bracketed as in Darsow et al. (see below and compare with Darsow process on the previous page):

-continued



(in various stereoconfigurations)

Therefore, one of ordinary skill in the art would ascertain that the absence of brackets in Hall et al. means two distinct hydrogenation steps. The presence of brackets in Darsow teaches a single hydrogenation step with two different outcomes.

For these reasons, the examiner would be justified in withdrawing the rejection of the claims based on Darsow in view of Hall et al. and Robinson et al.

Closing

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 (10 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: **26 January 2004**

By: Agata Glinska
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